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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/906,365	08/05/97	BHAT	R 0646/01205

DARBY AND DARBY
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NEW YORK NY 10022

HM11/1222

EXAMINER

BAS1,N

ART UNIT

PAPER NUMBER

1646

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DATE MAILED:

12/22/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/906,365

Applicant(s)
BHAT et al

Examiner
Nirmal. S. Basi

Group Art Unit
1646



☒ Responsive to communication(s) filed on Oct 7, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2, 9, and 10 is/are rejected.

☒ Claim(s) 3-8 and 11-16 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1646

DETAILED ACTION

1. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1646.

5 The Amendment filed 10/7/98 has been entered.

2. Applicant's election with traverse of claims 1-16 (Group I) in Paper No. 5 (Filed 10/5/98) is acknowledged. The traversal is on the ground(s) that "the groups designated by the Examiner fail to define products, methods for using such products, and methods for producing such products, and with biological properties so distinct as to warrant separate examination and search" and the
10 Applicant asserts that a search of all the groups would be co-extensive and would not pose an undue burden on the Examiner. This is not found persuasive because a search of Invention I, II, III and IV would not be co-extensive as shown by the separate classifications, an examination of the materially different, patentably distinct inventions in a single application would constitute undue burden on the examiner.

15 As pertaining to Groups I and II Applicants traversal, "that it is irrelevant that polypeptide can be made from some other process. The relevant question is whether the process can produce some other product", is not found persuasive. When the inventions are related as process of making and product made the inventions are distinct if **either or both** of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product
20 as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the

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instant case as indicated in the Office action dated 9/3/98 the product may be isolated from its natural source or made by chemical peptide synthesis . Furthermore, the applicants traversal that, "the polypeptide of Group II is related to the method of Group III as product and process of using it" and "that it is irrelevant that the product could be used in some other process", is not found persuasive.

5 When inventions are related as product and process of use the inventions can be shown to be distinct if **either or both** of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the proteins may be used for the production of antibodies of invention IV as stated in the Office action
10 dated 9/3/98 .

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections, 35 U.S.C. 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the
15 basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20 (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claims 1, 2, 9 and 10 rejected under 35 U.S.C. 102(e) as being anticipated by Kausch et al.

(A). Kausch et al. disclose the isolation of human and mouse chromosomes (column 5). The cell source are human and mouse cells (column 6, lines 5-15). Many chromosomes can be sorted at once (column 9, lines 29-43). Large amounts of pure chromosomes may be isolated (column 10, lines 22-25), and the DNA from the chromosome is used for transfection into host cell (column 10, lines 22-34). Claims 1, 2, 9 and 10 encompass chromosomal DNA because the claims read on nucleic acid comprising nucleotide sequence of SEQ ID NO:1 or encoded the polynucleotide of by SEQ ID NO:2. The disclosure of Kausch et al. meets the limitations of Claims 1, 2, 9 and 10 because the host cell inherently contained the afore mentioned nucleic acid molecules in the purified and isolated chromosomes.

Claims 1, 2, 9 and 10 rejected under 35 U.S.C. 102(b) as being anticipated by Lin et al. (B).

Lin et al. disclose the isolation of chromosomes from human lymphocytes (Fig. 2). Claims 1, 2, 9 and 10, encompass chromosomal DNA because the claims read on nucleic acid comprising nucleotide sequence of SEQ ID NO:1 or encoded the polynucleotide of by SEQ ID NO:2. The disclosure of Lin et al. meets the limitations of Claims 1, 2, 9 and 10 because the host cell inherently contained the afore mentioned nucleic molecules in the purified and isolated chromosomes shown in Fig 2.

4. Claims 3-8 and 11-16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Advisory Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nirmal Basi whose telephone number is (703) 308-9435. The examiner can normally be reached on Monday-Friday from 9:00 to 5:30.

5 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lila Feisee, can be reached on (703) 308-2731. The fax phone number for this Group is (703) 308-0294.

Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

10 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Nirmal S. Basi

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15 16 December, 1998

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LILA FEISEE
SUPERVISORY PATENT EXAMINER